

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
<div style="border-bottom: 1px solid black; padding-bottom: 5px;">I hereby certify that this correspondence is being transmitted via the Office electronic filing system in accordance with § 1.6 (a)(4) to the U.S. Patent and Trademark Office</div> <div style="border-bottom: 1px solid black; padding-bottom: 5px;">on April 19, 2007</div> <div style="border-bottom: 1px solid black; padding-bottom: 5px;">Signature </div> <div style="border-bottom: 1px solid black; padding-bottom: 5px;">Typed or printed name Susan E. Freedman</div>		<div style="border-bottom: 1px solid black; padding-bottom: 5px;">Application Number 09/733,306</div> <div style="border-bottom: 1px solid black; padding-bottom: 5px;">Filed 12/08/2000</div> <div style="border-bottom: 1px solid black; padding-bottom: 5px;">First Named Inventor Margaret A. Schwarz</div> <div style="border-bottom: 1px solid black; padding-bottom: 5px;">Art Unit 1633</div> <div style="border-bottom: 1px solid black; padding-bottom: 5px;">Examiner Janet L. Epps Ford</div>	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <div style="display: flex; justify-content: space-between; align-items: flex-start; margin-top: 20px;"><div style="width: 45%;"><p>I am the</p><div style="margin-bottom: 10px;"><input type="checkbox"/> applicant/inventor.</div><div style="margin-bottom: 10px;"><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</div><div style="margin-bottom: 10px;"><input checked="" type="checkbox"/> attorney or agent of record. Registration number _____</div><div style="margin-bottom: 10px;"><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</div></div><div style="width: 50%; text-align: center;"><div style="border-top: 1px solid black; margin: 5px auto; width: 80%;">Signature Shawna Cannon Lemon</div><div style="border-top: 1px solid black; margin: 5px auto; width: 80%;">Typed or printed name</div><div style="border-top: 1px solid black; margin: 5px auto; width: 80%;">919-854-1400</div><div style="border-top: 1px solid black; margin: 5px auto; width: 80%;">Telephone number</div><div style="border-top: 1px solid black; margin: 5px auto; width: 80%;">April 19, 2007</div><div style="border-top: 1px solid black; margin: 5px auto; width: 80%;">Date</div></div></div>			
<p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			
<div style="border: 1px solid black; padding: 5px;"><input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.</div>			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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**RESPONSE UNDER 37 C.F.R. 1.116
EXPEDITED PROCEDURE
EXAMINING GROUP 1633**

Attorney Docket No. 9022-20

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Schwarz	Confirmation No. 3192
Serial No.: 09/733,306	Group Art Unit: 1633
Filed: December 8, 2000	Examiner: Janet L. Epps Ford
For: METHODS OF FACILITATING VASCULAR GROWTH IN CARDIAC MUSCLE AND METHODS FOR THE PRODUCTION OF RECOMBINANT EMAP II	

April 19, 2007

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**REASONS IN SUPPORT OF APPLICANT'S PRE-APPEAL
BRIEF REQUEST FOR REVIEW**

Sir/Madam:

Applicant hereby requests a Pre-Appeal Brief Review (hereinafter "Request") of the claims finally rejected in the final Office Action dated January 19, 2007.

No fee or extension of time is believed due for this request other than those submitted with the petition for extension of time filed concurrently herewith. However, if any further fee or extension of time for this request is required, Applicant requests that this be considered a petition therefor. The Commissioner is hereby authorized to charge any additional fee, which may be required, or credit any refund, to our Deposit Account No. 50-0220.

REMARKS

Applicant appreciates the continued thorough examination of the present application as evidenced by the final Office Action dated January 19, 2007 (hereinafter, "Final Action"). Claims 1, 2, 7-11, 17-19, 47 and 48 are pending in the present application, and Applicant respectfully submits that the claim rejections under 35 U.S.C. § 103 are based on a clear error by the Examiner in interpreting the claims, and a clear error in understanding the cited references.

Accordingly, Applicant respectfully requests review of the present application by an appeal conference prior to the filing of an appeal brief in the interest of brevity and without waiving the right to argue additional grounds should this Request be denied.

It is well accepted that in order to establish a *prima facie* case of obviousness, the cited reference or references when combined must teach or suggest *all* the recitations of the claims, and there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. M.P.E.P. §2143, *see also Dystar Textilfarben v. C.H. Patrick* 06-1088 (Fed. Cir. Oct. 3, 2006).

Moreover, Applicant contends that the combination of cited references could only have been used to support the obviousness rejection through the impermissible use of hindsight to reconstruct the claimed invention, using the applicant's own disclosure as a guide. As stated in *In re Ruschig*:

Working backward from a knowledge of chlorpromamide, that is by hindsight, it is all very clear what route one would travel through the forest of the specification to arrive at it. But looking at the problem, as we must, from the standpoint of one with no foreknowledge of the specific compound, it is our considered opinion that...[n]ot having been specifically named or mentioned in any manner, one is left to select from the myriads of possibilities encompassed by the broad disclosure, with no guide indicating or directing that this particular selection should be made rather than any of the many others which could also be made.

In re Ruschig, 379 F.2d 990, 995, 154 U.S.P.Q. 118 (CCPA, 1967).

The claims of the present application relate to methods of facilitating vascular growth in cardiac muscle of a human subject in need of such treatment, comprising inhibiting activity of EMAP II of SEQ ID NO:4 in said human subject by administering an antibody that

specifically binds to EMAP II of SEQ ID NO:4 as well as methods of facilitating vascular growth in cardiac muscle tissue of a human subject in need of such treatment, said method comprising administering to said human subject an antibody that specifically binds to EMAP II of SEQ ID NO:4 in an amount effective to promote blood vessel formation in said cardiac muscle.

U.S. Patent Application Serial No. 2003/0215421 to McDonald et al. (hereinafter, "McDonald et al.") relates to *conjugates* that are used to treat inflammatory responses associated with activation, proliferation and migration of immune effector cells, including leukocyte cell types, neutrophils, macrophages and eosinophils. More specifically, these conjugates "contain one or more chemokine-receptor targeting agents linked, either directly or via a linker, to one or more targeted agents are provided. In particular, conjugates provided herein contain the following components: (chemokine receptor targeting agent)_n, (L)_q, and (targeted agent)_m in which at least one chemokine receptor targeting agent, such as a chemokine peptide or chemokine receptor-specific antibody, or an effective portion thereof, is linked directly or via one or more linkers (L) to at least one targeted agent." McDonald et al., paragraph [0035].

A *conjugate*, even after onerous picking and choosing to select an antibody specific for EMAP II as a component of the conjugate to treat inflammatory conditions, does not teach or suggest the methods of facilitating vascular growth as recited in the pending claims. Moreover, conjugation is clearly a significant aspect of the technology provided by McDonald. As such, Applicant respectfully submits that one of ordinary skill in the art would not look to this reference directed to the use of *conjugates* for modification in order to arrive at the present invention.

U.S. Patent No. 6,914,128 to Salfeld et al. (hereinafter, "Salfeld et al.") relates to human antibodies that bind human IL-12. Applicant recognizes that such antibodies are purported to be useful to treat a laundry list of diseases involving immune and inflammatory elements (see column 74, line 28 through column 75, line 43); however, Salfeld et al. does not recite that such antibodies can be used to facilitate vascular growth in cardiac muscle.

Again, only after onerous picking and choosing, one of ordinary skill in the art may arrive at a combination therapy including the antibody that binds the human IL-12 and an antibody to EMAP II. However, this combination is cited as useful for the treatment of

inflammatory bowel disease (Salfeld et al., column 77, lines 2 through 32) and multiple sclerosis (Salfeld et al., column 78, lines 13 through 24). Salfeld et al. does not teach or suggest the methods of facilitating vascular growth recited in the pending claims.

U.S. Patent No. 5,641,867 to Stern et al. (hereinafter, "Stern et al."), as cited in the Final Action, presents antibodies that specifically bind to EMAP II polypeptide and further discusses the antibodies in a buffer. *See* Final Action, page 4. However, a mere discussion of the antibody, alone or in a buffer, does not cure the deficiencies of MacDonald et al. or Salfeld et al. and does not provide any teaching, suggestion or motivation to arrive at the present invention.

It appears that the Examiner has made a clear error by misinterpreting the disclosure of the cited references. There is no teaching or suggestion by the cited references to facilitate vascular growth in cardiac muscle of a human subject in need of such treatment, comprising inhibiting activity of EMAP II of SEQ ID NO:4 in said human subject by administering an antibody that specifically binds to EMAP II of SEQ ID NO:4 (Claim 1), or to facilitate vascular growth in cardiac muscle tissue of a human subject in need of such treatment, said method comprising administering to said human subject an antibody that specifically binds to EMAP II of SEQ ID NO:4 in an amount effective to promote blood vessel formation in said cardiac muscle (Claim 11). Further, there is no motivation to combine these references. The impetus to arrive at the present invention is clearly and impermissibly derived from the teachings of the present disclosure and the recited claims.

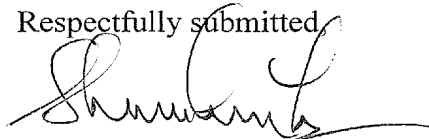
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Filed: December 8, 2000
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Conclusion

In view of the foregoing remarks, Applicant respectfully requests that all outstanding rejections to the claims be withdrawn.

The Examiner is invited and encouraged to contact the undersigned directly if such contact will expedite the prosecution of the pending claims to issue. In any event, any questions regarding this application should be directed to the undersigned, who may be reached at (919) 854-1400.

Respectfully submitted,



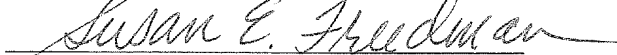
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CERTIFICATION OF TRANSMISSION

I hereby certify that this correspondence is being transmitted via the Office electronic filing system in accordance with § 1.6(a)(4) to the U.S. Patent and Trademark Office on April 19, 2007.



Susan E. Freedman

Date of Signature: April 19, 2007